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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,035	05/03/1999	GIORGIO J. VANZINI	MSI-254US	9156

22801 7590 03/27/2002

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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/304,035

Applicant(s)

VANZINI ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03/06/02 (Response).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response*

1. Receipt is acknowledged of the response filed 06 March 2002. Applicant's request for  
5 reconsideration of the finality of the rejection of the last Office action is persuasive and,  
therefore, the finality of that action is withdrawn.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 15 (e) the invention was described in a patent granted on an application for patent by another  
filed in the United States before the invention thereof by the applicant for patent, or on an  
international application by another who has fulfilled the requirements of paragraphs (1),  
(2), and (4) of section 371(c) of this title before the invention thereof by the applicant for  
patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999  
(AIPA) do not apply to the examination of this application as the application being examined  
20 was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.  
122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment  
by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 5, 22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Valliani et al. (US 6,234,389).

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Re claims 1, 2, and 22, Valliani teaches PCMCIA-compliant device 200 comprising a card reader slot 230, which reads smart cards and magnetic cards (col. 1, lines 23-45; Abstract). Embodiment utilizing smart card is further elaborated in figure 7 (col. 7, lines 49+).

Re claims 5 and 24, Valliani further teaches that the passcode such as PIN number is  
5 stored in the memory 225 of a smart card 230 (col. 5, lines 30-40).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or  
described as set forth in section 102 of this title, if the differences between the subject  
matter sought to be patented and the prior art are such that the subject matter as a whole  
would have been obvious at the time the invention was made to a person having ordinary  
15 skill in the art to which said subject matter pertains. Patentability shall not be negated  
by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various  
20 claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 3, 4, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valliani (US 6,234,389) in view of Dedrick (US 5,701,884). The teachings of Valliani have been discussed above.

Although Valliani teaches that host machine uses a flash memory (col. 4, lines 4+),  
5 Valliani fails to specifically teach or fairly suggest that the PCMCIA assembly comprised of a flash memory and the assembly is used in accessing user profile data.

Dedrick teaches a system for updating personal profile in the network environment allowing the users to connect to the network utilizing PCMCIA based smart card 11 with flash memory (col. 1, lines 12+; col. 2, lines 5-10). Data on the smart card is to be accessed with a  
10 passcode or PIN (col. 6, lines 59 – 66), and data collected from the smart card and user interaction is used to configure system elements to accommodate users (col. 6, lines 36 – 45; col. 7, lines 39 – 48). Once smart card is removed from the interface, user related data is deleted from the RAM (col. 6, lines 22 – 33; col. 7, lines 5 – 8).

In view of Dedrick's teaching, it would have been obvious to an ordinary skill in the art  
15 at the time the invention was made to incorporate well-known parameter type of data to the teachings of Valliani in order to expand the functionality of a smart card. By adding such elements, not only the smart card functions as a data carrier for transactions, it can serve as a network access cards, or change any of network setting as desired. For example, it can be used in changing e-mail address (or any other network parameters users allowed to change), so that e-  
20 mails can be routed to different destinations. Therefore, such modification would have been an obvious extension as taught by Valliani to expand the usage of a smart card, and therefore an obvious expedient.

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4. Claims 6, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valliani et al. (US 6,234,389) in view of Jones et al (US 5,623,637). The teachings of Valliani have been discussed above.

Although Valliani teaches encryption in generic terms, Valliani fails to specifically teach  
5 or fairly suggest of encryption where private key resides on smart card and public key is on the host.

Jones teaches an encryption scheme where smart card 400 holds private key 430 and the host 410 has a matching public key 455 (col. 8, lines 47+; figure 3).

In view of Jones' teaching, it would have been obvious to an ordinary skill in the art at  
10 the time the invention was made to employ notoriously well-known encryption scheme where private key resides on a smart card and public key is available on the host (i.e., PC or the network) to the teachings of Valliani in order to provide secure communication between the host and a smart card, and protect important/sensitive data from being stolen, and thus an obvious expedient.

15

### ***Response to Arguments***

5. As indicated in the applicant's Remarks section (Paper #10), the examiner misinterpreted the pending claims in previous Office Actions (Paper #6 and #9), which the applicant clearly  
20 explained during the telephone conference. Accordingly, the finality of the rejection is withdrawn as agreed during the conference, and thus this Office Action is made non-final.

### ***Conclusion***

25 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Bates, III (US 6315206); Potdevin et al. (US 5679007); Klatt et al. (US 6069795);

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Ungermann et al. (US 6053775); Klatt et al. (US 5877488); Postlewaite (US 6015092) disclose PCMCIA card accepting another card and related methods.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim  
Patent Examiner  
Art Unit 2876  
March 19, 2002

  
MICHAEL G. LEE  
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